



29 MAY 2008

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In re Application of DONALD et al. :
Application No.: 10/590,563 : DECISION ON PETITION
PCT No.: PCT/GB05/00725 :
Int. Filing: 25 February 2005 : UNDER 37 CFR 1.47(a)
Priority Date: 26 February 2004 :
Attorney Docket No.: CMRN:0051/SWA OTE-031085 :
For: CONNECTION SYSTEM FOR SUBSEA FLOW :
INTERFACE EQUIPMENT :

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 13 December 2007, to accept the application without the signatures of joint inventors ALAN CRAWFORD AND PAUL W. WHITE. Applicant's request for a five month extension of time is granted.

BACKGROUND

On 24 August 2006, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 14 May 2007, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 13 December 2007, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventors. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requests the acceptance of the application without the signatures of inventors ALAN CRAWFORD AND PAUL W. WHITE, alleging that Messrs. CRAWFORD and WHITE refuse to sign the application.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor was provided. With regard to item (4), the declaration executed by the available joint inventors on their behalf and on behalf of the non-signing inventors were submitted. Item (4) is satisfied.

Inventor's Refusal to Sign

With respect to Item (2) above, the declaration by John Reid, joint inventor and employee for DES Enhanced Recovery Limited., was attached to the petition, detailing the efforts made to obtain the nonsigning inventors' signatures. Mr. Reid detailed his attempts to contact the nonsigning inventors via their attorney. According to Mr. Reid's declaration, on 21 August 2006, he sent Mark Barnett, the attorney for the nonsigning inventors, a letter requesting the signatures of inventors Crawford and White on the following documents: "US assignment document, Canadian Assignment document and Power of attorney document". The 21 August 2006 letter makes no mention that a copy of the application including specification, claims (and drawings if any) and declaration was enclosed. On 16 November 2006, Mr. Reid telephoned Mr. Barnett regarding the non-signing inventors' signatures on the documents. According to Mr. Reid, attorney Barnett confirmed that "he had read PCT/2005/000725 and that he was unwilling to authorize either Alan Crawford or Paul White to sign either the Declaration/Power of Attorney or the Assignments, and therefore refused to authorize the inventors to sign the papers".

On the same date, in an email communication, the nonsigning inventors' attorney Barnett reiterated that "after careful consideration of the request and a review of the documents to which these assignments would apply, I am *unwilling to authorize them to sign the assignments* for the reasons I provided on our telephone call today." (Emphasis added.) This is not evidence that the non-signing inventors refused to sign the *declarations* relating to this application. No mention of an unwillingness to authorize the inventors signatures on the declarations was made by Mr. Barnett.

The fact that the attorney was unwilling to authorize the inventors to sign the assignment documents cannot be construed as a refusal to sign the declaration. Petitioner has not provided proof as set forth in Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.¹ Petitioner has not provided evidence that a complete copy of the application papers was presented to the non-signing inventors and their refusal to sign the application. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

¹ A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

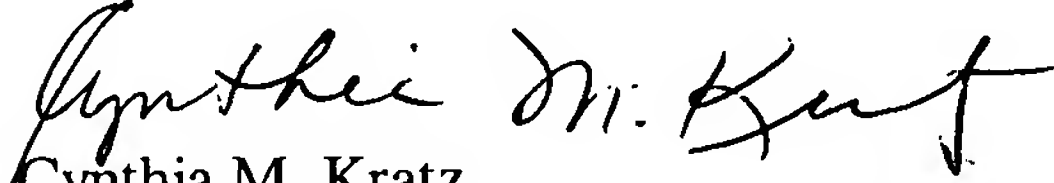
When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition. (Emphasis added.)

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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